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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/805,099	03/13/2001	Gayle Marie Frankenbach	8244	2087

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THE PROCTER & GAMBLE COMPANY
INTELLECTUAL PROPERTY DIVISION
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CINCINNATI, OH 45224

EXAMINER

KHAN, AMINA S

ART UNIT	PAPER NUMBER
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1751

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/02/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

09/805,099

Applicant(s)

FRANKENBACH ET AL.

Examiner

Amina Khan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 November 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11, 15-18, 22-53 and 56-80 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11, 15-18, 22-53 and 56-80 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

DETAILED ACTION

1. This office action is in response to applicant's amendments filed on November 13, 2006.
2. Claims 1-11, 15-18,22-53 and 56-80 are pending. Claims 12-14,19-21 and 51-55 are cancelled. Claims 1,22,23,26,27,34,35,53,56,57,64,65,70,74 and 75 are amended.
3. Claims 1-11,15-18,22-53 and 56-80 stand rejected under 35 U.S.C. 102(e) and 35 U.S.C. 103(a) under Frankenbach et al. (US 6,491,840) for the reasons set forth in the previous office action. The rejection of the claims is maintained.

Priority

4. The applicant's claim of the continuation-in-part status from US application No. 09/634,379, now US 6,491,840 B1 is denied since the submission of the C-I-P status exceeds four months from the actual filing date of the application, February 13, 2001, or sixteen months from the filing date of the prior application.

If applicant desires to claim the benefit of a prior-filed application under 35 U.S.C. 119(e) or 120, a specific reference to the prior-filed application in compliance with 37 CFR 1.78(a) must be included in the first sentence(s) of the specification following the title or in an application data sheet. For benefit claims under 35 U.S.C. 120, 121 or

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365(c), the reference must include the relationship (i.e., continuation, divisional, or continuation-in-part) of the applications.

If the instant application is a utility or plant application filed under 35 U.S.C. 111(a) on or after November 29, 2000, the specific reference must be submitted during the pendency of the application and within the later of four months from the actual filing date of the application or sixteen months from the filing date of the prior application. If the application is a utility or plant application which entered the national stage from an international application filed on or after November 29, 2000, after compliance with 35 U.S.C. 371, the specific reference must be submitted during the pendency of the application and within the later of four months from the date on which the national stage commenced under 35 U.S.C. 371(b) or (f) or sixteen months from the filing date of the prior application. See 37 CFR 1.78(a)(2)(ii) and (a)(5)(ii). This time period is not extendable and a failure to submit the reference required by 35 U.S.C. 119(e) and/or 120, where applicable, within this time period is considered a waiver of any benefit of such prior application(s) under 35 U.S.C. 119(e), 120, 121 and 365(c). A benefit claim filed after the required time period may be accepted if it is accompanied by a grantable petition to accept an unintentionally delayed benefit claim under 35 U.S.C. 119(e), 120, 121 and 365(c). The petition must be accompanied by (1) the reference required by 35 U.S.C. 120 or 119(e) and 37 CFR 1.78(a)(2) or (a)(5) to the prior application (unless previously submitted), (2) a surcharge under 37 CFR 1.17(t), and (3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2) or (a)(5) and the date the claim was filed was unintentional. The Director may require additional

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information where there is a question whether the delay was unintentional. The petition should be addressed to: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450.

If the reference to the prior application was previously submitted within the time period set forth in 37 CFR 1.78(a), but not in the first sentence(s) of the specification or an application data sheet (ADS) as required by 37 CFR 1.78(a) (e.g., if the reference was submitted in an oath or declaration or the application transmittal letter), and the information concerning the benefit claim was recognized by the Office as shown by its inclusion on the first filing receipt, the petition under 37 CFR 1.78(a) and the surcharge under 37 CFR 1.17(t) are not required. Applicant is still required to submit the reference in compliance with 37 CFR 1.78(a) by filing an amendment to the first sentence(s) of the specification or an ADS. See MPEP § 201.11.

Specification

5. The disclosure is objected to because of the following informalities: the amendments submitted on November 13, 2006 are objected to because the applicant cannot claim the continuation-in-part status of US 6,491,840 for the reasons set forth in paragraph 4 above.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

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The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 1-11, 15-18,22-53 and 56-80 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The claim language "by prospective consumers who are not experienced in fabric care operations" recited in claim 1 is considered new matter. The added limitation in the claim lacks literal basis in the specification as originally filed, see *Ex parte Grasselli*, 231 USPQ 393 (Bd. App. 1983) *aff'd mem.* 738 F.2d 453 (Fed. Cir. 1984).

Claims 2-11,15-18,22-53 and 56-80 are also rejected for being dependent on rejected base claim 1 and inheriting the same deficiency.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the

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United States and was published under Article 21(2) of such treaty in the English language.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-11,15-18,22-53 and 56-80 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Frankenbach et al. (US 6,491,840).

Frankenbach et al. teaches methods of removing wrinkles by providing a wrinkle removal composition which may be used without heat and providing a set of instructions (column 84, lines 21-51) to apply said composition to wrinkles and to manipulate the fabric to remove wrinkles and let the fabric dry (column 85, lines 28-53), as claimed in claim 1.

Frankenbach further teaches that the compositions comprise at least 0.5% but less than 15% by weight water-soluble solvent (column 15, lines 1-30), which meets the claimed limitations of claims 2-6. Frankenbach further teaches that the compositions comprise perfumes (column 55, lines 51-60), which meets the claimed limitation of claim 9, silicone surfactants (column 16, lines 23-25), which meets the claimed limitation of claim 10, and lithium salts (column 31, lines 29-67), as claimed in claim 1. Frankenbach

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further teaches that the composition is provided in a container and the set of instructions is also provided associated with the container (column 84, lines 22-25), which meets the claimed limitations of claim 11.

Frankenbach further teaches that the instructions disclose to use a hair dryer to blow air across the fabric (column 89, lines 19-36), which meets the claimed limitation of claim 15. Frankenbach further teaches stretching or smoothing of the fabric by hand (column 88, lines 34-44), which meets the claimed limitations of claims 16 and 17. Frankenbach further teaches pinching the fabric with hands to reinforce creases or pleats (column 88, lines 55-67), which meets the claimed limitations of claim 18. Frankenbach further teaches that the instructions provide benefits other than wrinkle removal such as reducing odors, improving softness, etc. (column 84, lines 40-46). Frankenbach further teaches that the compositions are useful to treat garments for extending the time before another wash cycle is needed (column 86, lines 50-55), which meets the claimed limitations of claim 41.

Frankenbach further teaches that the compositions be held in a spray dispenser specifically a non-manual powered sprayer (column 79, lines 15-20), which meets the claimed limitations of claims 38 and 39. Frankenbach further teaches that the sprayer stream will be released by a triggering mechanism (column 79, 42-44), which meets the claimed limitations of claim 40. Frankenbach further teaches how to treat fabrics after improper storage, specifically after compression from storage in tight containers or after being left in the dryer too long after the end of the drying cycle (column 87, lines 9-16), which meets the claimed limitations of claims 42 and 43.

Frankenbach further teaches that the instructions comprise instruction to treat fabrics with 5-150% by weight of the fabric of the composition (column 85, lines 30-40), which meets the claimed limitations of claim 44. Frankenbach further teaches that the composition be applied evenly over fabric (column 87, lines 55-56) using a sweeping motion (column 87, lines 52-55), which meets the claimed limitations of claims 45 and 46. Frankenbach further teaches that the compositions be more highly dosed over wrinkled sites (column 87, lines 57-60) and the fabric sprayed from at least 6 inches but less than 12 inches away (column 87, lines 35-47), which meets the claimed limitations of claims 47, 48 and 49. Frankenbach further teaches that the composition be applied to household fabrics while the household fabrics reside in their typical environment, such as shower curtains being treated on the rod and table linens treated on the table (columns 91-92, lines 64-32), which meets the claimed limitations of claim 50. Frankenbach further teaches that the composition be applied to fabrics while on the hanger (column 92, lines 42-52).

Regarding the claimed limitation of "uniform composition when at rest" and a composition with a flash point greater than 60°C, while the prior art is silent about the claimed properties, they would be inherent to the composition because the composition comprises the same components at the same percentages (water miscible solvent, perfumes, and starch).

Regarding claims 22-37, 52, 53 and 56-80, which further limit the instructional information provided to the consumer, Frankenbach teaches including instructions either printed on the container itself or presented in a separate manner including, but

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not limited to, a brochure, print advertisement, electronic advertisement, and/or broadcast communication so as to communicate the set of instructions to a consumer of the article of manufacture (column 77, lines 35-67), which meets the claimed limitations of the instant claims. Frankenbach et al. further teaches that the set of instructions can comprise the instruction or instructions to achieve the benefits discussed in the patent by carrying out any of the methods of using wrinkle controlling compositions as described in the patent (column 84, 45-51).

Regarding the claimed limitations of "promoting the acceptance/usage" and "convincing said consumers that composition performance is genuine thereby encouraging said consumers to incorporate composition usage into said consumers' habits" as recited in claim 1, the limitations were given little patentable weight because they simply recite intended use and do not further limit the method steps of the instant claims. The teachings of Frankenbach et al. meet the method step limitations of the instant claims. Accordingly, the teachings of Frankenbach et al. anticipate the material limitations of the instant claims.

In the alternative, the claimed limitations of "promoting acceptance/usage", "convincing said consumers that composition performance is genuine thereby encouraging said consumers to incorporate composition usage into said consumers' habits" and the claimed limitations on instructional information would have been obviously provided by the process as disclosed by Frankenbach et al. because Frankenbach et al. teaches similar compositions with similar methods for treating fabrics

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and similar forms of instructional information to highlight the benefits of the fabric treatments when applied by the taught methods.

Furthermore, regarding applicant's recitation of what is disclosed by the instructions, "Where sole distinction set out in claims over prior art is in printed matter, there being no new feature of physical structure and no new relation of printed matter to physical structure, such claims may not be allowed; it is only where claims define either new features of structure or new relations of printed matter to structure, or both, which new features or new relations give rise to some new and useful function, effect, or result, that claims may be allowed; particular branch of art considered does not change these principles." *Ex parte Gwinn* 112 USPQ 439. As the compositions are obvious, and the instructions do not give rise to a new and useful function, effect or result, they do not contribute a patentable difference to applicant's invention, and thus are not accorded any patentable weight.

Where the only difference between a prior art product and a claimed product is printed matter that is not functionally related to the product, the content of the printed matter will not distinguish the claimed product from the prior art. *In re Ngai*, ^{***}367 F.3d 1336, 1339, 70 USPQ2d 1862, 1864 (Fed. Cir. 2004) (Claim at issue was a kit requiring instructions and a buffer agent. The Federal Circuit held that the claim was anticipated by a prior art reference that taught a kit that included instructions and a buffer agent, even though the content of the instructions differed.). See also *In re Gulack*, 703 F.2d 1381, 1385-86, 217 USPQ 401, 404 (Fed. Cir. 1983) ("Where the printed matter is not functionally related to the substrate, the printed matter will not distinguish the invention from the prior art in terms of patentability [T]he critical question is whether there exists any new and unobvious functional relationship between the printed matter and the substrate.").

Response to Arguments

9. Applicant's arguments regarding Frankenbach et al. (US 6,491,840) have been fully considered but they are not persuasive.

The applicant argues:

"i.) With regard to the § 102 rejections, it is noted that various elements of the claims as now amended are not disclosed in the '840 document, e.g., the inexperienced prospective consumer, the directions designed to convince said consumers of the composition's performance to encourage usage, etc. Accordingly, under the settled case law, since all elements of the claims are not found in '840, the rejections under § 102 cannot stand.

ii.) With regard to the § 103 rejections previous remarks regarding discovery of a problem and its solution as buttressing patentability continue to apply. It is noted that the Examiner did not rebut this legal issue in the most recent Office Action.

Moreover, nothing in '840 suggest "targeting" specific inexperienced prospective consumer groups, e.g., in Claims 23 and 74. Nothing in '840 suggests co-marketing, per Claim 75, in order to encourage trial of the composition by non-experienced users. Thus, in particular regard to these claims, it is submitted that the rejections do not meet the requirements of §103."

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The examiner respectfully disagrees. Frankenbach et al. clearly teach that the instructional information provided to the consumer may include information on carrying out any of the methods of using wrinkle controlling compositions as described in the patent (column 84, 45-51). Regarding the legal issue of "discovery of a problem and its solution as buttressing patentability" the examiner has addressed this argument with the following case law:

Where the only difference between a prior art product and a claimed product is printed matter that is not functionally related to the product, the content of the printed matter will not distinguish the claimed product from the prior art. *In re Ngai*, **>367 F.3d 1336, 1339, 70 USPQ2d 1862, 1864 (Fed. Cir. 2004)< (Claim at issue was a kit requiring instructions and a buffer agent. The Federal Circuit held that the claim was anticipated by a prior art reference that taught a kit that included instructions and a buffer agent, even though the content of the instructions differed.). See also *In re Gulack*, 703 F.2d 1381, 1385-86, 217 USPQ 401, 404 (Fed. Cir. 1983)("Where the printed matter is not functionally related to the substrate, the printed matter will not distinguish the invention from the prior art in terms of patentability [T]he critical question is whether there exists any new and unobvious functional relationship between the printed matter and the substrate.").

Regarding the claimed limitations of "promoting the acceptance/usage" and "convincing said consumers that composition performance is genuine thereby encouraging said consumers to incorporate composition usage into said consumers' habits", the limitations were given little patentable weight because they simply recite intended use and do not further limit the method steps of the instant claims. The teachings of Frankenbach et al. meet the method step limitations of the instant claims. Accordingly, the teachings of Frankenbach et al. anticipate the material limitations of the instant claims.

In the alternative, the claimed limitations of “promoting acceptance/usage”, “convincing said consumers that composition performance is genuine thereby encouraging said consumers to incorporate composition usage into said consumers’ habits” and the claimed limitations on instructional information would have been obviously provided by the process as disclosed by Frankenbach et al. because Frankenbach et al. teaches similar compositions with similar methods for treating fabrics and similar forms of instructional information to highlight the benefits of the fabric treatments when applied by the taught methods.

For the reasons cited above the rejection is maintained.

Conclusion

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

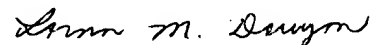
11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amina Khan whose telephone number is (571) 272-5573. The examiner can normally be reached on Monday through Friday, 8:30-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Douglas McGinty can be reached on (571) 272-1029. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Amina Khan
Patent Examiner
January 29, 2007


LORNA M. DOUYON
PRIMARY EXAMINER